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Group Art Unit	3621
Examiner Name	James A. Reagan
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ENCLOSURES *(check all that apply)*

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  - [ ] Affidavits/declaration(s)
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- [ ] Appeal Communication to Board of Appeals and Interferences
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- [ ] Proprietary Information
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- [ ] Other Enclosure(s) *(please identify below)*:

Remarks

Applicant's Reply Brief For Appeal (6 pages in triplicate)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	KIRK M. HARTUNG
Signature	Kirk M. Hartung
Date	

CERTIFICATE OF MAILING

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#10/Reply Brief
1-22-03
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF:	METHOD AND MEANS FOR EVALUATING CUSTOMER SERVICE PERFORMANCE	Appeal No.
SERIAL NO:	09/255,968	**APPLICANT'S REPLY BRIEF FOR APPEAL**
FILED:	FEBRUARY 23, 1999	
FOR:	VISION INSIGHT LLC	
Group Art Unit:	3621	
Examiner:	JAMES A. REAGAN	
Attorney Docket No:	P03735US0	

Assistant Commissioner of Patents
Washington, D. C. 20231

Dear Sirs:

In response to the Examiner's Answer dated November 18, 2002, Applicant submits the following remarks.

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this **APPLICANT'S REPLY BRIEF FOR APPEAL FOR PATENT APPLICATION SERIAL NO. 09/255,968 for NANCY L. ANDERSON and LOIS J. PANNKUK** and documents referred to as enclosed therein are being deposited with the U. S. Postal Service in an envelope as "Express Mail Post Office to Addressee" addressed to: Assistant Commissioner of Patents, Box Appeal, Washington, D.C. 20231, prior to 5:00 p.m. on 15 day of January, 2003.

Kirk M. Hartung

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REMARKS

A. THE CLAIMS DISTINGUISH OVER THE CITED REFERENCES

Independent claim 1 is directed towards a method of evaluating customer service performance "of a specific employee at a point of transaction and at a time of transaction." Similarly, independent claim 23 is directed towards a method of evaluating customer service performance "of an employee at a point of transaction and at a time of transaction." Independent claim 31 is directed towards a system for collecting customer feedback " of an employee's performance at a point of transaction and at a time of transaction." Each of these independent claims requires that at the point of transaction and the time of transaction the customer be presented with a question about the employee's performance and respond to the question. These limitations are not taught or suggested by the cited references, alone or in combination.

The Matyas patent, which is the primary reference relied upon by the Examiner in the rejection of the claims, discloses a method and means for conducting an Internet purchase of goods. The Examiner acknowledges that Matyas does not teach feedback about the employee's performance, as required by the claims. (Examiner's Answer, page 2). The Examiner relies upon the Cadotte patent as teaching the collection of survey information about employees. (Examiner's Answer, pages 2-3). The Examiner suggests that the motivation to combine Matyas and Cadotte is the increase customer feedback and the allowance for a more timely and accurate measure of customer satisfaction with regard to the efficiency of an employee. (Examiner's Answers, page 3). However, there is no clear and particular showing for this conclusion.

Both Matyas and Cadotte teaches customer feedback through surveys. There is no basis to conclude that the Cadotte surveys would <u>increase</u> customer feedback beyond the Matyas

surveys. To the extent the Examiner suggests that the increase in feedback relates to the efficiency of an employee, there would be no increase in such feedback in Matyas since no employee is present or utilized in the Matyas Internet transaction. There is no reason to ask employee performance questions in the Matyas transaction since there is no employee in Matyas to evaluate. Therefore, the Examiner's suggested combination of Matyas and Cadotte is improper.

More particularly, as the Federal Circuit in *In re Fitch* stated:

> "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a proported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added) *In re Fitch* 23 U.S.P.Q. 1780, 1783-84 (Fed. Cir. 1992).

It was further stated by the Federal Circuit in *Ex Parte Levengood* that:

> " . . . an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence that the motivating force which would impel one skilled in the art to do what the patent applicant has done". *Ex Parte Levengood*, 28 U.S.P.Q. 1300, 1302 (Fed. Cir. 1993).

As the Board of Patent Appeals and Interferences has stated, "citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient bases for concluding that the combination of claimed elements would have been obvious." *Ex parte Hiyamizu*, 10 U.S.P.Q.2d 1393, 1394 (BPAI 1988).

In short, as stated by the Federal Circuit,

> "It is wrong to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims-in-suit."

Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

The Federal Circuit has also explained that there must be "some objective teaching" leading to the combination. *In re Fitch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). As further explained in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) this showing must be "clear and particular."

Here, the Examiner has provided no clear and particular objective teaching leading to the combination of Matyas and Cadotte. Therefore, the § 103 obviousness rejection should be reversed.

B. THE EXAMINER HAS MISCONSTRUED THE MATYAS PATENT

On page 2 of the Examiner's Answer, the Examiner asserts that Matyas teaches presenting a question to a customer "at the point of transaction" and obtaining a response to the question from the customer "at the point of transaction." Matyas undisputably relates to Internet transactions. However, in such Internet transactions, it is debatable whether there is any "point of transaction", and if there is such a point, is it at the buyer's end, the seller's end, or some place in cyberspace? (There is substantial discussion among state governments concerning the "point of transaction" issue with regard to Internet sales, since the states each want the sales tax revenue generated by such transactions.) Matyas does not teach any "point of transaction" and the Examiner fails to identify any "point of transaction" in Matyas.

On page 11 of the Office Action, the Examiner concludes that "a purchase made over the Internet from a home computer is equivalent to a point of transaction and a point of sale made from any retail establishment." However, the Examiner ignores one of the primary differences between an Internet sale and a retail sale, that is, the face to face interaction which is absent in an Internet transaction. One of the primary objectives of the present invention is the evaluation of employee performance. However, as discussed above, in the Internet transaction of Matyas, there is no employee to evaluate.

The Examiner further states on page 11 of his Answer that the survey conducted by the Matyas invention is completed "at a time of the transaction." To the contrary, there is no such teaching or suggestion in Matyas. Matyas clearly states that the product survey information is collected from buyers that have "previously purchased products from the seller" (col. 3, lines 6-9), and that the buyer "later provides survey information to the evaluator" (col. 3, lines 29-30). There is no disclosure in Matyas that the surveys be conducted at the time of transaction or purchase. Therefore, the Examiner's conclusions on page 11 of his Answer are unsupported by the Matyas patent.

The Examiner quotes on page 10 from the Matyas background and discussions of SET protocols and POS transactions. This is merely background information and does not broaden the scope or disclosure of the Matyas patent beyond its Internet transaction. On page 14, the Examiner states that "the transactions and the survey conducted by the Matyas invention are completed 'at a point of transaction and at a time of transaction.'" However, neither the Examiner nor Matyas identify the "point" of the transaction, and Matyas clearly teaches that the surveys are conducted later for previous purchasers of the goods.

C. CONCLUSION

There is no clear and particular objective teaching leading to the combination of Matyas and Cadotte. Also, the Examiner's interpretation of Matyas is not supported by the Matyas Specification or drawings. Therefore, the § 103 obviousness rejection based upon Matyas and Cadotte should be withdrawn.

Respectfully submitted,

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